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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,386	11/23/2001	Raymond John Herbert	5081	4332
26936	7590	02/01/2006	EXAMINER	
SHOEMAKER AND MATTARE, LTD 10 POST OFFICE ROAD - SUITE 110 SILVER SPRING, MD 20910			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	
DATE MAILED: 02/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,386

Applicant(s)

HERBERT, RAYMOND JOHN

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Status of Claims

1. Claims 1-4 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 comprises an authorized printing means for printing a postage indicium on a mail item. Claim 1 also describes control means for preventing a void marking from causing a postage indicium to be printed on a mail item by said authorizing means. To one of ordinary skill this is not supported by Applicant's Specification. To the contrary, Applicant discloses preventing the void marking from being printed and not the indicium (Specification, figures 2 and 3;

page/line 8/17-9/11; page 9, lines 16-28), which is how the Examiner is interpreting the operation of the claimed "second control means".

Claims 2-4 are also rejected as they depend from claim 1.

Claim 2 recites "... and wherein the second control means is responsive to a binary value of said determined bit position to reject strings of print data in which the determined bit position has the second binary value." Applicant's Specification, on the other hand, discloses detecting a bit position to prevent transmission of any print string that corresponds to a void marking (Specification, page 8, lines 32-37). Therefore, Applicant lacks support for using a bit position to reject strings of print data as once the bit position is detected a void mark or second data signal is not sent. For purposes of examination, the Examiner is interpreting the above claim 2 limitation as follows: "... and wherein the second control means is responsive to a binary value of said determined bit position to *prevent transmission of* strings of print data in which the determined bit position has the second binary value."

Claim 3 recites means to "... reject print data signals defining the void marking and not defining the valid postage indicium". However, this contradicts the operation of Applicant's postage meter as disclosed in Applicant's Specification. Specifically, Applicant teaches printing a valid indicium when the void mark is not printed (figures 2 and 3). Claim 4 is also rejected as it is similar to claim 3.

Claim 4 is directed to using a bitmap to inhibit operation of the authorized printing means by print signals that define a void marking. However, the Specification recites, using a bitmap of the void print data to remove void print data from a print data signal (Specification, page 9, lines 23-29). Therefore, claim 4 is not supported by the Specification.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites first control means that defines "a void marking" and "not defining the valid postage indicium". However, claim 1 from which claim 3 depends recites first control means for defining a valid indicium and a void marking. Therefore, to one of ordinary skill the operation of the first control means of claim 3 contradicts its operation according to claim 1 (An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous- *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)). Claim 4 is also rejected as it is similar to claim 3.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sievel et al., U.S. Patent No. 4,780,835.

As per claim 1, Sievel et al. teach a postage meter (column 4, lines 11-19) that includes a first control means for generating print signals defining an invalid postage indicium where the print signals comprise a void marking and a valid postage indicium (figure 5B). Sievel et al. also teach authorized means for printing an indicia (figure 1) and means for preventing the void marking from being printed (figure 5B).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sievel et al., U.S. Patent No. 4,780,835.

As per claim 2, Sievel et al. teach a printer printing an indicia (figure 1) and preventing a void marking from being printed along with an indicia (figure 5B). The printer receives data to be printed from a server (i.e. processor, memory, input/processor) (figure 1; column/line 3/57-4/10), therefore to one of ordinary skill, the data or print signals is expressed in binary form. Further, when tampering is not detected, the server instructs the printer to print a postage indicium and a validation (i.e. not void) mark (column 8, lines 45-58), hence the server [processor] (figure 1) prevents transmission of a void marking (figure 5B).

As per claim 3, it is well known to those of ordinary skill in postage metering to disable a postage meter if it is not operating correctly. Therefore, an obvious modification to the meter of Sievel et al. is to prevent the meter from printing if the system detects an error such as a print signal that comprises a void and an improper postage indicium (figure 5B).

As per claim 4, Sievel et al. teach printing a predefined void marking (column 8, lines 53-54). Sievel et al. do not specifically recite storing void markings as a bitmap. However, storing image and/or data to be printed on a mailpiece as a bitmap in memory is old and well-known, therefore, it would have

been obvious to one of ordinary skill to print the postage and void marking of Sievel et al. using bitmaps.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Gilham discloses storing image data such as pattern data in bitmap memory
- Arsenault et al. disclose storing data to be printed on a mailpiece as a bitmap
- Berson et al. teaches printing a "void" mark over an indicia
- Durst et al. disclose disabling a postage printer upon detecting an error
- Connell et al. disclose disabling a meter when a void is detected
- Check Jr. discloses identifying errors in data and control signals and interrupting operations

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

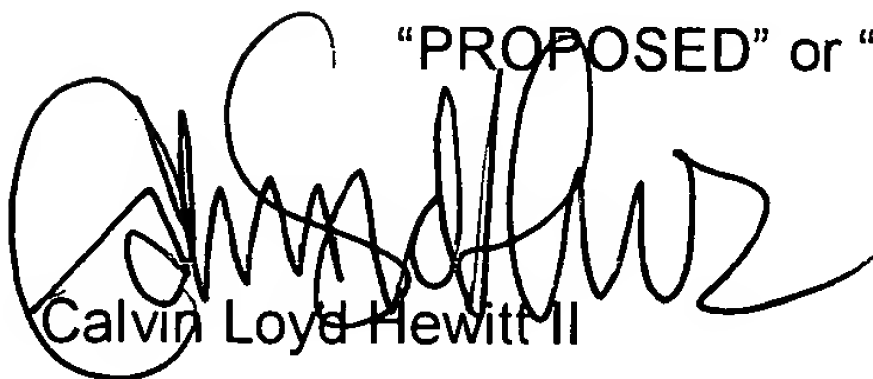
or faxed to:

(571) 273-8300 (for formal communications intended for entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")



Calvin Loyd Hewitt II

January 27, 2006